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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------|------------------|
| 09/868,356 | 08/10/2001 | Thomas D. Gordon | 00537-188002 | 7156 |
| 37903 | 7590 | 05/24/2005 | EXAMINER | |
| DAWN JANELLE AT BIOMEASURE INC. 27 MAPLE STREET MILFORD, MA 01757 | | | COLEMAN, BRENDA LIBBY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1624 | |

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,356

Applicant(s)

GORDON ET AL.

Examiner

Brenda L. Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,6,8 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,15,16,20 and 21 is/are rejected.
- 7) ☒ Claim(s) 5,7,9,10,12-14 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-16 and 19-21 are pending in the application.

This action is in response to applicants' amendment dated February 28, 2005.

Claims 1, 13, 15 and 20 have been amended.

Response to Arguments

Applicant's arguments filed February 20, 2005 have been fully considered with the following effect:

1. The applicant's amendments are sufficient to overcome the improper Markush rejection of claims 1, 2, 5, 7, 15, 16, 20 and 21 labeled paragraph 4) in the last office action, which is hereby **withdrawn**.

2. The applicant's amendments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled paragraph 5b), c), d) and e) in the last office action, which are hereby **withdrawn**. However, with regards to the 35 U.S.C. § 112, second paragraph rejection labeled a) in the last office action, the applicant's amendments and remarks have been fully considered but they are not persuasive.

g) The applicants' state that they have amended the definition of R⁶ restricting same to H or an aryl substituted with X¹, X² and X³, and the definition of R⁷, restricting same to =O, -H, =S or an aryl substituted with X¹, X² and X³. However, in view of the proviso R⁶ is H, then R¹⁰ and R⁷ are taken together to form a phenyl ring substituted by X¹, X² and X³ and when R⁷ is =O, -H or =S then R¹⁰ and R⁶ are taken together to form a phenyl ring substituted by X¹, X² and X³, thus at no time is R⁶ an aryl or R⁷ an aryl.

Claims 1, 2, 5, 7, 13, 15, 16, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for reasons of record and stated above.

3. The applicant's amendments and arguments are sufficient to overcome the obviousness-type double patenting rejection of claims 15 and 16 labeled paragraph 6) in the last office action, which is hereby **withdrawn**.

In view of the amendment dated February 20, 2005, the following new grounds of rejection apply:

Election/Restrictions

4. This application contains claims 3, 4, 6, 8 and 11 drawn to an invention nonelected with traverse in Paper dated May 15, 2003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 2, 15, 16, 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the invention, at the time

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the application was filed, had possession of the claimed invention. The amendment to the definition of R⁶ where R⁶ is an aryl substituted with X¹, X² and X³ and the definition of R⁷ where R⁷ is an aryl substituted with X¹, X² and X³ is not described in the specification. X¹, X² and X³ are defined as H, halogen, NO₂ NHCOR⁸, CN or CON(R⁸R⁹) where the definition of the substituted moieties of R⁶ and R⁷ are OH, (C₁₋₆)alkyl, (C₁₋₆)alkoxy, N(R⁸R⁹), COOH, CON(R⁸R⁹) and halo.

Applicant is required to cancel the new matter in the reply to this Office action.

Claim Objections

6. Claims 5, 7, 9, 10, 12-14 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda L. Coleman
Primary Examiner Art Unit 1624
May 20, 2005